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1 UNITED STATES DISTRICT COURT
2 SOUTHERN DISTRICT OF NEW YORK

3 LEIGHTON TECHNOLOGIES, LLC,

4 Plaintiff-Counterclaim Defendant,

5 v.

04 Civ. 2496(CM)

6 MARKMAN HEARING

7 OBERTHUR CARD SYSTEMS, S.A.,

8 Defendant-Counterclaim Plaintiff.
9 -----x

10 White Plains, N.Y.
11 February 9, 2005
12 10:00 a.m.

13 Before:

14 THE HONORABLE COLLEEN McMAHON,

15 District Judge

16 APPEARANCES

17
18 SUTHERLAND, ASBILL & BRENNAN, LLP
19 Attorneys for Plaintiff-Counterclaim Defendant
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JAMES DAVID JACOBS
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Also present: MIREILLE CLAPIER, Oberthur inhouse counsel

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1 At the very start this morning, your Honor, I
2 explained, or I tried to explain, that Leighton's invention
3 here was built on a lot of prior art, and during the file
4 wrapper, he set forth that his purpose was to protect -- and
5 that's the wrong section -- was to protect the chip.

6 THE COURT: It was to manufacture the card without
7 having the core, but, nonetheless, not damaging the electronic
8 element.

9 MR. J. JACOBS: Very well said, your Honor. Thank
10 you.

11 THE COURT: Thank you.

12 MR. J. JACOBS: You can't apply pressure before you
13 heat the core. Otherwise, you're going to crack the sensitive
14 electronic element. And I think, as a result of our second
15 point, we made the point of the sensitivity to the electronic
16 element. It's the microchip, because the antenna is a mere
17 wire, plus not being an electronic element, of course.

18 All these, at least from my viewpoint -- and I hope
19 we've -- if we haven't done it already -- convinced the Court
20 that all these definitions sort of tie together. These aren't
21 isolated words that we've selected to bring to the Court's
22 attention. It really goes back to this amendment which now I
23 have on the screen, which describes how Leighton got this
24 patent allowed. And it was this highly coordinated pressure,
25 heating, cooling cycle.

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1 flow doesn't occur until it reaches the temperature. The same
2 thing with Claim 1.

3 The point here is, your Honor, you don't want to put
4 any pressure, or at least no more than a minimal pressure, on
5 the sandwich prior to you reaching a temperature where there's
6 a controlled flow. So in both (i) in Claim 1 and in Claim 16,
7 it's the heating with no pressure or little pressure until it
8 reaches a temperature where there is a controlled flow.

9 THE COURT: My question to you is, is the term first
10 pressure, as used in (ii) under Claim 1, in your opinion, the
11 same thing as first ram pressure in Claim 16, (c)(i)?

12 I'll tell you what the right answer is, because your
13 client is nodding his head, and the right answer is always what
14 your client says.

15 MR. J. JACOBS: I see my client nodding his head, but
16 I didn't understand the question.

17 THE COURT: The two terms that are highlighted, are
18 they the same thing?

19 MR. J. JACOBS: No, they're not, your Honor.

20 THE COURT: Okay. Why not?

21 MR. J. JACOBS: Because the first pressure in step
22 (ii) is the pressure which causes the controlled flow. The
23 second pressure in (ii) causes the controlled flow.

24 THE COURT: I'm absolutely not following what you're
25 saying. I'm sorry. I'm very thick after lunch.